

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BILLY G. CHESSER, GREGORY A. MULLEN,
and DAVE CLARK

Appeal No. 2001-0951
Application No. 08/869,109

ON BRIEF

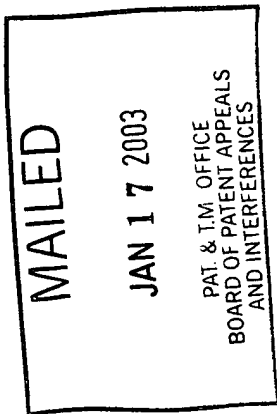
Before GARRIS, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is hereby remanded to the examiner for appropriate action consistent with our comments below.

Our study of the file record for this application reveals confusion with respect to the claims which are pending and on appeal. For example, on each of pages 1 and 2 of the brief (paper no. 24), the listing of finally rejected claims which are on appeal does not include claim 23. However, claim 23 is presented in the appendix of the brief and is included in the



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examiner's statement of rejection as presented on page 2 of the final office action (paper no. 20) and as presented on page 3 of the answer (paper no. 25). Additionally, on page 2 of the brief, the appellants state "[a]llthough 'claim 27' was appealed, Appellant submits that there is no claim 27, but that original claim 27 was renumbered as claim 26." This statement clearly reflects confusion as to the status and numbering of claim "27"/claim "26." Additional confusion exists with respect to claims 16 and 23 in that these claims as presented in the brief appendix correspond to original claims 16 and 23 which, according to the application file record, were renumbered¹ as claims 15 and 22 respectively and then canceled.

Upon return of this application to the jurisdiction of the Examining Corps., the examiner must communicate to the appellants the status, content and numbering of all claims now pending in the application file. Moreover, the appellants must respond to this communication in such a way as to ultimately clarify in the minds of both the examiner and the appellants an understanding

¹As originally filed, this application presented claims 1-13 and 15-27 (i.e., the originally filed application contained no claim "14"). As a result, claims 15-27 were respectively renumbered as claims 14-26 in accordance with 37 CFR § 1.126. This circumstance appears to have generated the claim confusion discussed above.

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and agreement as to this claim status, content and numbering.

In addition to the foregoing, we observe that the appellants' reply brief (paper no. 26) presents arguments to which the examiner has not responded on the record of this appeal.² For example, the reply brief includes argument regarding the polymer concentrations disclosed in the applied prior art (i.e., U.K. Patent Application, GB, 2084586) and presents "EXHIBIT I" for the calculations by which appellants determined these prior art concentrations. The record before us is completely silent as to whether the examiner has considered this exhibit and, if so, whether the examiner agrees with the concentration calculations set forth therein.

Therefore, upon return of this application to the jurisdiction of the Examining Corps., the examiner must respond, ("e.g., via a supplemental examiner's answer") to the arguments as well as the exhibit calculations presented in the reply brief so as to thereby clarify whether the examiner agrees with any such arguments and calculations, and if not, why not.

²The examiner's only comment (see paper no. 27) regarding this reply brief is that it "has been considered and noted."

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This application, by virtue of its "special" status, requires an immediate action; See the Manual of Patent Examining Procedure (MPEP), § 708.01(D) (8th Ed., Aug. 2001). It is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

BRADLEY R. GARRIS

BRADLEY R. GARRIS
Administrative Patent Judge

Peto T. Kurb

PETER F. KRATZ
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Beverly A Pawlowski

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

BRG:hh

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